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FACSIMILE COVER LETTER

To: Examiner E. McElwain
Firm: PTO
Facsimile No.: 703-308-4242
From: THOMAS J. KOWALSKI
Date: July 30, 2001
Re: USSN 09/489,817
OUR REF: 674550-2001
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PATENT
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Rahman et al.
Serial No. : 09/489,817
For : ORGANISM
Filed : January 24, 2000
Examiner : E. McElwain
Art Unit : 1638

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30 July 2001
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RESPONSE TO OFFICE ACTION

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

In response to the Office Action dated July 19, 2001, and in response to the Restriction Requirement dated March 22, 2001, please consider the following requests and remarks.

The Office Action, dated March 22, 2001, required restriction from among:

- I. Claims 1-3, drawn to a transformed CC genome;
- II. Claims 4-10, drawn to a transformed plant comprising an exogenous transparent seed coat;
- III. Claims 11-17, drawn to a yellow seed with transparent seed coat and specified levels of erucic acid and glucosinolates;
- IV. Claim 18, drawn to use of a yellow seed;
- V. Claim 19, to the extent that it is drawn to seed oil from yellow seeds;
- VI. Claim 19, to the extent that it is drawn to seed meal from yellow seeds;

- VII. Claims 20-26, drawn to a method for increasing levels of seed oil and protein and reducing fiber in a seed;
- VIII. Claims 27, 34 and 35, drawn to a transformed *Brassica napus* plant;
- IX. Claim 28, to the extent that it is drawn to seed oil;
- X. Claim 28, to the extent that it is drawn to seed meal;
- XI. Claims 29-31, drawn to use of an AA genome as a vector;
- XII. Claim 32, drawn to a transparent seed coat encoded by a gene; and
- XIII. Claim 33, drawn to a transparent seed coat.

In response, Group I, formerly Claims 1-3, drawn to a transformed CC genome, now Claims 36-44 (9 claims in total, involving a transformed *Brassica* CC genome; see also previous Response at page 11), is elected, with traverse.

As a traverse, it is noted that the MPEP lists two criteria for a proper restriction requirement.

First, the inventions must be independent or distinct, MPEP § 803. It is respectfully submitted that the claims herewith all comply with Group I.

Second, searching the additional inventions must constitute an undue burden on the examiner if restriction is not required. *Id.* The MPEP directs the examiner to search and examine an entire application “[i]f the search and examination of an entire application can be made without serious burden, ...even though it includes claims to distinct or independent inventions.” *Id.*

Each of the new claims is tied together by the single inventive concept that a *Brassica* CC genome is transformed with a transparent seed coat gene obtained from a *Brassica* AA genome to produce a transformed *Brassica* plant comprising the transparent seed coat gene and thus *Brassica* yellow seed. Claims 36-81, 101, 107 and 108 are product claims, whereas Claims 82-100, 102-106 and 109 are method claims.

The method claims are tied to the product claims and thus must be searched and examined together in this application, pursuant to the February 28, 1996 “Guideline on Treatment of Product and Process Claims ...”, published at 1184 TMOG 86 (March 26, 1996) and MPEP §821.04, as Claims 82-100, 102-106 and 109 encompass method claims dependent upon or involving the product claims, Claims 36-81, 101, 107 and 108.

Indeed, Claims 36-44 involve a transformed *Brassica* CC genome. Claims 45-54 and 108 involve plants containing such a genome. Claims 55-81 involve seeds containing such a genome. Claims 82-100 and 109 involve methods for making the genome, plants and seeds. Claim 101 involves a *Brassica napus* plant with a transparent seed coat. And, Claims 102-106 involve methods of using the *Brassica* AA genome as a vector, akin to the means for obtaining the claimed products, and a subspecies of claimed methods. Accordingly, there is unity of invention and no undue or serious burden in searching and examining all of the claims herewith. Moreover, at least some rejoinder of product and method claims is in order.

It is noted that the transparent seed coat gene provides the yellow color seed, as the coat is transparent thus enabling the yellow interior of the seed to be visualized (see page 2, third full paragraph of the specification). Indeed, in the corresponding UK application, GB 001714.5, claims directed to transformed plants and seeds with a transparent seed coat, and methods of increasing levels of seed oil and protein were all deemed to have unity of invention. As such, there is evidence that the present claims have unity of invention, are directed to a single inventive concept, and present no serious or undue burden to search and examine entirely within this application. And again, at least some rejoinder of product and method claims is in order.

It is thus respectfully submitted that the claims herewith are subject to being searched and examined together, and that a search of all the claims now presented does not pose a serious or undue burden upon the Examiner. Accordingly, it is further respectfully submitted that the restriction requirement was improper and that with this election and previously supplied new claim set, all of the new claims, including the new methods, should be searched, examined and rejoined.

REQUEST FOR INTERVIEW

If any issue remains as an impediment to allowance or as an impediment to prosecution on the merits proceeding, a telephonic interview is respectfully requested prior to issuance of any paper other than a Notice of Allowance; and the Examiner is respectfully requested to contact the undersigned to arrange a mutually convenient time and manner therefor.

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CONCLUSION

Early and favorable examination on the merits of all of the claimed subject matter or at least early and favorable examination of Claims 36-44 with rejoinder of some method claims, i.e., at least some reformulation of the restriction requirement and prompt issuance of a National Allowance are respectfully requested. The Commissioner is hereby authorized to charge any fee occasioned by this paper, or credit any overpayment in such fees, to Deposit Account No. 50-0320.

Respectfully submitted,

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